

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

GROUP ART UNIT 2162

Patent Application

Serial No. 09/219,478

Filed: December 22, 1998

Examiner: Michael Pender

I, MICHAEL SMIALEK, hereby certify that this correspondence is being deposited with the US Postal Service as express mail with mailing label number:

EK655805018US

in an envelope addressed to Assistant Commissioner for Patents, Washington, D.C. 20231, on the date of my signature.

Signature

Michael Smialek 7/14/2000

Signature

Date

PROTEST UNDER 37 CFR 1.291

Assistant Commissioner for Patents  
Washington, D.C. 20231  
Attn: Director of Examining Group 3107

Sir:

The undersigned hereby protests against the allowance of the above-identified patent application in light of the facts that the invention was in commercial use by the applicant for more than 1 year before the filing date, and inventorship of the patent may be fraudulently misrepresented.

As required under 37 CFR 1.291, the undersigned certifies that a copy of this correspondence, including all accompanying documents, is being deposited with the US Postal Service as first class mail in an envelope addressed to:

L. Keith Stephens  
PO Box 52037  
Palo Alto, CA 94303-0746

Mr. Stephens is listed by the Patent Office as applicant's attorney or agent in the file wrappers of related applications.

Summary of Submitted Exhibits

- A. Affidavit of Michael Smialek.
- B. Affidavit of Michael Rubin.
- C. Employee Performance Review from Andersen Consulting, documenting the performance and contributions of Michael Smialek as an employee of Andersen Consulting for the employment period 7/15/1995 – 11/30/1995.
- D. Employee Performance Review from Andersen Consulting, documenting the performance and contributions of Michael Smialek as an employee of Andersen Consulting for the employment period 12/1/1995 – 8/31/1996.
- E. Management Contribution Summary from Andersen Consulting, documenting the contribution of Michael Smialek to Andersen Consulting programs and initiatives for the employment period September 1995 – August 1996.
- F. Letter from L. Keith Stephens to Michael Smialek dated 12/16/1999.
- G. Letter from Michael Smialek to L. Keith Stephens, and others dated 2/9/2000.
- H. Fax from Robert Beiser to Michael Smialek of a letter from Kevin Rhodes to Robert Beiser dated 2/25/2000.
- I. Letter from Michael Smialek to Examiner Michael Pender dated 6/15/2000.
- J. Time Report from Andersen Consulting, documenting activities of Michael Smialek for the reporting period 2/16/1997 – 2/28/1997
- K. Printout of a web page from Andersen Consulting's web site excerpting their FY 1997 annual report.
- L. Contact information for current and former Andersen Consulting employees with first hand knowledge of material facts.

## Concise Explanation of the Relevance of Submitted Exhibits

### A. Affidavit of Michael Smialek.

Statements of fact from Michael Smialek, a former Andersen Consulting employee, regarding the inventorship and first commercial use of the subject matter of the patent application in question.

Exhibit A substantiates commercial use of all the subject matter disclosed in the specification of said application more than one year before the filing date. Such commercial uses make the subject matter ineligible for patent therefore no claims claiming the subject matter would be valid. Exhibit A also substantiates probable misrepresentation of inventorship. It further substantiates that if such misrepresentation exists it is likely deliberate, therefore invalidating the application.

Exhibit A refers to several current Andersen Consulting employees: William Stoddard, David Smith, Janet Simons, and John Hubbell. It is requested that the Examiner direct specific questions to these individuals as well as those named as inventors on the application in question. The Examiner can get contact information for these individuals by calling any of the following phone numbers: 800-777-0009, 847-714-6800, 630-377-3100.

### B. Affidavit of Michael Rubin.

Statements of fact from Michael Rubin, a former Andersen Consulting employee, regarding the inventorship of the subject matter of the patent application in question. Exhibit B substantiates probable misrepresentation of inventorship. It further substantiates that if such misrepresentation exists it is likely deliberate, therefore invalidating the application.

### C. Employee Performance Review from Andersen Consulting, documenting the performance and contributions of Michael Smialek as an employee of Andersen Consulting for the employment period 7/15/1995 – 11/30/1995.

This employee performance review covers part of Michael Smialek's participation on an Andersen Consulting client engagement for General Electric corp. called the GE FFC project. The review was created by Suzanne Pink, Michael Smialek's supervising manager during the period. It was approved by Janet Simons, currently a Partner at Andersen Consulting. Janet Simons was the most senior Andersen Consulting employee with daily involvement on the GE FFC engagement.

Exhibit C demonstrates that Michael Smialek was the primary inventor of the "rules based expert system" known internally at Andersen Consulting as the Tutor. This exhibit also demonstrates that the Tutor was used commercially, on a for fee client engagement, more than one year before the filing date of the application in question. Some of the relevant areas of the exhibit have been highlighted.

D. Employee Performance Review from Andersen Consulting, documenting the performance and contributions of Michael Smialek as an employee of Andersen Consulting for the employment period 12/1/1995 – 8/31/1996.

This employee performance review covers part of Michael Smialek's activities from 12/1/1995 through 8/31/1996. During the period of December 1995 through May 1996, Michael Smialek was involved full-time on the GE FFC project mentioned above. From May 1996 through August 1996, Michael Smialek led an effort to enhance, document, and package Andersen Consulting's business simulation technologies for reuse on other client engagements.

The review was created by Suzanne Pink, Michael Smialek's supervising manager during the period. It was approved by David Smith the project manager of the GE FFC engagement.

Exhibit D demonstrates that Michael Smialek was the primary inventor of the "rules based expert system" known internally at Andersen Consulting as the Tutor. It also demonstrates that Michael Smialek was the primary inventor of the workbenches and testing facilities known internally at Andersen Consulting as the Tutor Workbench and Regression Test Bench, respectively. The exhibit further demonstrates that the Tutor

was used commercially, on a for fee client engagement, more than one year before the filing date of the application in question.

Near the top of page 9 of Exhibit D, the review says "Mike Created a very complex document for describing the tutor and how it functions." This refers to one of the several documents authored or co-authored by Michael Smialek that make up substantial portions of the specification in the patent application. Michael Smialek's name was prominently displayed on these documents, substantiating that the applying attorney had knowledge of Michael Smialek's inventorship.

Near the top of page 10, Exhibit D says "Also, Mike independently developed a presentation describing how several existing tools could be integrated to improve Andersen's solution delivery capability, and increase its market share in the knowledge worker market." This refers to a presentation known internally at Andersen Consulting as "Knowledge Worker Tools" authored solely by Michael Smialek. Excerpts from this presentation are used extensively in the specification of the patent application. Michael Smialek's name was prominently displayed on this document.

At the top of page 16, Exhibit D states that Michael Smialek was the primary contributor of the Tutor. It goes on to mention the "second semester of the FMP program". This refers to a second client engagement for General Electric Corp. called FAO. It was on this project that the "spreadsheet object component", known internally at Andersen Consulting as the Simulation Engine was first used commercially in October 1996. Michael Smialek conceived of and contributed the conceptual design of the simulation engine. Benoit Bertrand contributed the detailed design of the simulation engine and reduced it to practice on the FAO engagement. Some of the relevant areas of the exhibit have been highlighted.

- E. Management Contribution Summary from Andersen Consulting, documenting the contribution of Michael Smialek to Andersen Consulting programs and initiatives for the employment period September 1995 – August 1996.

This management contribution summary documents Michael Smialek's contributions to the Tutor, Simulation Engine, editing and testing workbenches, Profiling technology, and Knowledge Worker Tools. It also substantiates the commercial usage of that subject matter in conjunction with Andersen Consulting client engagements.

**F. Letter from L. Keith Stephens to Michael Smialek dated 12/2/1999.**

This letter was sent shortly after the issuance of related patent 5987443. This letter is addressed to Michael Smialek, however it starts "Dear Mr. Mitchell:". A similar letter was sent to at least one other former Andersen Consulting employee named Scott Mitchell. The error seems to be the result of a botched copy/paste operation.

The letter states "We are familiar with Knowledge Dynamics products." even though L. Keith Stephens has never reviewed any Knowledge Dynamics products. It substantiates that L. Keith Stephens was well aware of Michael Smialek, his contributions to the subject matter, and his contact information. It is therefore suggested that omission of Michael Smialek from the inventorship would be fraudulent.

**G. Letter from Michael Smialek to L. Keith Stephens, and others dated 2/9/2000.**

This letter was sent to L. Keith Stephens to clarify the inventorship and statutory bar defects in the related patents that had issued as of 2/9/2000. It was copied to two other Andersen Consulting attorneys: Vicki St. John and Kevin Rhodes. It was also copied to Michael Smialek's attorney, Robert Beiser. It substantiates that Andersen Consulting's legal representatives have full knowledge of the inventorship and statutory bar issues and have had sufficient time to exercise their duty to disclose such information to the PTO.

**H. Fax from Robert Beiser to Michael Smialek of a letter from Kevin Rhodes to Robert Beiser dated 2/25/2000.**

This was the only Andersen Consulting response to the 2/9/200 letter of Exhibit G. It was sent from Kevin Rhodes to Robert Beiser. Robert Beiser faxed it to Michael Smialek. It substantiates that Andersen Consulting's legal representatives have full knowledge of the inventorship and statutory bar issues and have had sufficient time to exercise their duty to disclose such information to the PTO.

**I. Letter from Michael Smialek to Examiner Michael Pender dated 6/15/2000.**

Exhibit I was sent to Examiner Pender to disclose facts related to inventorship and first commercial use.

**J. Time Report from Andersen Consulting, documenting activities of Michael Smialek for the reporting period 2/16/1997 – 2/28/1997.**

Exhibit J is a time report from Andersen Consulting. It shows the date that Michael Smialek demonstrated subject matter in question to employees of Allstate Insurance Co. The exhibit substantiates a commercial use of subject matter of the omnibus specification more than one year before the filing date.

**K. Printout of a web page from Andersen Consulting's web site excerpting their FY 1997 annual report.**

Andersen Consulting's fiscal year runs from September through August. In Exhibit K, the annual report from 1997 speaks of the Pratt & Whitney BDM business simulation in the past tense, demonstrating that Andersen Consulting's business simulation inventions were in commercial use more than one year before the filing date.

**L. Contact information for current and former Andersen Consulting employees with first hand knowledge of material facts.**

Contact information for people who can confirm relevant facts.

**Conclusion**

~~The submitted exhibits substantiate that all the subject matter of the omnibus specification was in commercial use for well over a year before the filing date of the application~~

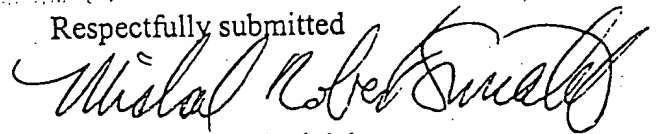
and are therefore ineligible for patent. It further substantiates that Michael Smialek is likely the actual primary inventor or a contributing inventor. Accordingly, it is respectfully submitted that all of the claims of the pending application should be rejected. It is suggested that the Examiner verify these assertions by investigating beyond the statements of any agent of Andersen Consulting. It is suggested that the Examiner seek comment directly from individuals with first hand knowledge of the facts, specifically, the inventors named in application 09/219,478, as well as current Andersen Consulting executives named herein.

If the Examiner determines that the subject matter is still eligible for patent in spite of the evidence presented here, it is submitted that Michael Smialek should be named as an inventor.

This protest was prepared in haste in order that it be received by the Examiner prior to issuance of notice of allowance of application 09/219,478. Undersigned notifies Examiner that more evidence may be forthcoming as it becomes available, and requests that Examiner accept said evidence and amend it hereto.

The undersigned is available for further consultation by the Examiner.

Respectfully submitted



Michael Robert Smialek

Michael R. Smialek  
1548 Meadow Lane  
Glenview, IL 60025  
847-869-1595  
847-486-0501